

Notice of Allowability

Application No.

09/763,387

Examiner

Frances P. Oropeza

Applicant(s)

BRAND ET AL.

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/13/04 (Appeal).
2. ☒ The allowed claim(s) is/are 7-17.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 7.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

ALLOWANCE

Reasons for Allowance

1. Claims 7-17 are allowed. The following is an examiner's statement of reasons for allowance: The subject matter of the independent claim could either not be found or was not suggested in the prior art. The subject matter not found was a "a pacemaker comprising a metallic housing having a first wall with a first opening therein and a second wall with a second opening therein", and "a metallic tube member having a first tube end" "attached to said first opening" and "an opposite second tube end" "attached to said second opening", in combination with the other elements of the claims.

As to the prior art reference combination of Schiff (US 5383913) and Hawkins et al. (US 6029089), the Applicant successfully argues integrating the substantially continuous metal sleeve taught by Schiff, located in an epoxy housing, into the metal housing taught by Hawkins et al., would not have been obvious to one skilled in the art. Hawkins et al. teach a sleeve/ tube to surround the electrode (30) that is composed of different parts and materials. The numerous insulation and metal attachment issues created when attaching a substantially continuous metal sleeve into a metal housing are not addressed by Schiff nor Hawkins et al., hence the resulting invention would be non-functional. Key to this argument is the understanding that the Schiff header is constructed from epoxy based on the typical material of construction at the time of the invention, the shadings of the drawings indicating non-metallic construction, and the lack of a more definitive description in the specification.

As to the prior art reference combination of Hawkins et al. (US 6029089) and Schiff

(US 5383913), Hawkins et al. teach a metallic housing. The tubular area providing the contact area for electrode (30) is not a continuous member, but rather made up of individual parts (figure 5). While there is no motivation to modify Hawkins with an electrode port on both ends of the housing, if one were to modify Hawkins et al. to provide an electrode port on both ends of the device, it would have been more obvious to duplicate and reverse the existing port rather than incorporate the teachings of Schiff. When considering combining Schiff with Hawkins et al., the addition of the substantially continuous sleeve of Hawkins to the metallic housing of Hawkins et al. would have presented the previously discussed issues of insulation and electrical functionality, making the invention non-functional.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Drawings

2. The proposed drawing correction of figures 1 and 2, filed on 1/8/03, has been accepted. A proper drawing correction or corrected drawing is required in reply to this Office action to avoid abandonment of the application. The correction to the drawing will not be held in abeyance.

The application having been allowed, a formal drawing of figures 1 and 2 including the label for "Prior Art" for both figures is required in response to this Office action to avoid abandonment of the application. The formal drawings will not be held in abeyance.

Art Unit: 3762

Conclusion

Any inquiry concerning this or earlier communications from the Examiner should be directed to Fran Oropeza whose telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communication and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

FPO
8/17/04

[Signature]
JEFFREY R. JASTRZAB
PRIMARY EXAMINER
8/18/04